



Docket No.: SON-2842
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takashi AOKI, et al.

Application No.: 10/526,490

Confirmation No.: 7483

Filed: March 4, 2005

Art Unit: 2624

For: IMAGE PROCESSING APPARATUS AND
IMAGE PROCESSING METHOD

Examiner: N. Bitar

PETITION UNDER 37 C.F.R. §1.144

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Petition under 37 C.F.R. §1.144 requesting review of the Restriction Requirement mailed in the Final Office Action of April 28, 2008, and timely traversed within the After-Final Amendment filed on June 11, 2008.

The Final Office Action of April 28, 2008 includes a restriction requirement under 35 U.S.C. §121. The Office Action further asserts that "[s]ince applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-14 are withdrawn from consideration as being directed to a non-elected invention."

In response, an election with traverse of that restriction requirement is found within the After-Final Amendment under 37 C.F.R. § 1.116 filed on June 11, 2008.

Page 2 of the Advisory Action mailed on July 25, 2008 maintains the restriction requirement.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper. See 37 C.F.R. §1.144.

RESTRICTION REQUIREMENT

The Final Office Action of April 28, 2008 includes a restriction requirement under 35 U.S.C. §121, which recites:

Newly submitted claims 7-14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

However, claims 7-14 discloses different embodiment of the invention where they teaches a memory module and a processor that issues a controller command to retrieve the trim image and the controller is configures to command the corresponding data reader to read only the trimmed image.

Page 3 of the Final Office Action of April 28, 2008

ELECTION

Applicant was forced to elect claim 1-6 without notice. The Examiner's position for this constructive election was that:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-14 are withdrawn from consideration as being directed to a non-elected invention.

Pages 3-4 of the Final Office Action of April 28, 2008

TRAVERSAL

For the reasons provided hereinbelow, the Restriction Requirement is respectfully *traversed*.

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why **>each invention< as claimed *>is< either independent or distinct >from the other(s)<; and (B) the reasons >why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons< for insisting upon restriction therebetween as set forth in the following sections.

MPEP § 808

The Examiner has failed to show the inventions to be independent or distinct

Regarding establishing the reasons each invention is either independent or distinct from the others:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. **A mere statement of conclusion is inadequate.** The reasons upon which the conclusion is based should be given.

MPEP § 808.01

The Final Office Action of April 28, 2008 asserts that “[n]ewly submitted claims 7-14 are directed to an invention that is independent or distinct from the invention originally claimed.”

However, the Office Action fails to cite any reasonable basis for any mutually exclusive characteristics between the present claims and claims 7-14. On the contrary, the **only** basis cited for not searching the new claims is the **narrower scope** of the new claims, in comparison to prior claims 1-6.

In setting forth the restriction, the Final Office Action states that:

claims 7-14 discloses different embodiment of the invention where they[sic] teaches *a memory module and a processor that issues a controller command to retrieve the trim image and the controller is configures to command the corresponding data reader to read only the trimmed image*”

Page 3 of Final Office Action (emphasis added).

Regarding the restriction requirements, the Advisory Action of July 25, 2008 further asserts:

Applicant has amended claim 7 and requested the rejoinder of claims 7-14. Note that amended claims 7-14 have never been examined because they were restricted out in the final rejection mailed 04/28/2008. Claim 7 is different

than claim 1 since claim 7 teaches the "control command" on line 8 to retrieve the trim image which is distinct from the teaching of claim 1. Moreover, Claim 1, requires to read image data for each column at a time from a memory while claim 7 requires to read ONLY the trimmed image portion from the memory. Therefore, the two claims are not the same scope and claim 714 are directed to an invention that is independent from the original claims 1-6.

Page 3 of the Advisory Action of July 25, 2008

However, both the Office Action and Advisory Action fail to argue set forth a clear logical basis as to why the claims are "either independent or distinct," thus warranting restriction.

First, the "*memory module*", "*processor*," and "*controller [] configure[d] to command the corresponding data reader to read only the trimmed image*" do not qualify as elements which would create a basis for *an independent or distinct invention*. At best, these elements may arguably recite a claim having *narrower scope* than that cited in claim 1. However, narrower scope cannot form the basis of a restriction. The inventions must be independent and distinct. In the present case, claim 1 simply includes an invention of broader scope than claim 7.

Second, even if claims 7-14 recited a narrower scope than claim 1 for the cited reasons, claim 7 does not have a significantly narrower scope than all of claims 1-6.

With respect to the use of the phrase "*in response to a controller command from a processor*," (which the Office Action cites as a basis for the restriction) claim 2 already recites an "*image processing apparatus ...wherein the controlling means is configured to supply address information...*"

With respect to the use of the phrase "*memory module*," (which the Office Action cites as the basis for the restriction) this feature alone fails to provide a proper or sufficient basis to argue that the original invention is distinct from the elected invention, as there is no possible basis for arguing that claim 1, which recites "*reading means for reading image data from a memory*", is patentably distinct from claim 7 on the basis of the inclusion of a "memory module."

Finally, the phrase “*the controller is configure[d] to command the corresponding data reader to read only the trimmed image*” (which the Office Action cites as the basis for the restriction) is clearly similar to “trimming out a part of image data stored in a memory and transferring the trimming image data” recited in claim 1. Accordingly, claim 1 clearly recites subject matter sufficiently similar to claim 7 to continue prosecution on all the pending claims.

Furthermore, an argument that claims 1-6 and claim 7-14 are directed to different species fails to form the basis for a restriction where one species is obvious over the other. In the present case, elements of claims 7-14 are found throughout claims 1-6. Furthermore, both sets of claims are drawn from a similar example embodiment.

Accordingly, there is no basis for citing distinctness or independence as a basis for a restriction.

The Examiner has failed to show why the invention recited in claim 7-14 would impose an undue burden.

Regarding establishing undue burden, the MPEP recites:

Where the * inventions as claimed are shown to be independent or distinct ... in order to establish reasons for insisting upon restriction, [the examiner] must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) *Separate classification thereof...*

(B) *A separate status in the art when they are classifiable together...*

(C) *A different field of search...*

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, **no reasons exist for dividing among independent or related inventions.**

MPEP § 808.02 (emphasis added)

Even if the invention recited in claims 7-14 were distinct or independent, the basis cited by the Examiner for issuing the restriction fails to qualify as an undue burden.

The cited reason for the present restriction is the “*memory module*”, “*processor*,” and “*controller [] configure[d] to command the corresponding data reader to read only the trimmed image.*”

None of the these additions qualify to as a basis to place claims 7-14 in a “[s]eparate classification thereof...[a] separate status in the art when they are classifiable together...[or a] different field of search” because none of the cited components would place claims 7-14 in a classification outside the “image processing” arts. While these claims may arguably be narrower than claims 1-6, these narrower elements would not move the claimed apparatus to a new art.

As such, claims 7-14 would not place an undue burden on examination.

RELIEF

For the reasons set forth above, Applicant requests that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper restriction.

FEE

No fee is believed to be required in connection with this petition.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: September 23, 2007

Respectfully submitted,

By  40,290

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